AF/ IEW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

Assignee's Docket No.:	8963.00
Group Art Unit:	3693
Serial No.:	09/826,612
Examiner:	Daniel S. Felten
Filing Date:	April 5, 2001
Title:	Self-Service Terminal

REPLY BRIEF

This Reply Brief is submitted in response to the Examiner's Answer mailed on March 31, 2010.

CERTIFICATE OF MAILING

I certify that this document is addressed to Mail Stop AF, Commissioner of Patents, PO Box 1450, Alexandria, VA 22313-1450, and will be deposited with the U.S. Postal Service, first class postage prepaid, on June 1, 2010.

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ANSWER, SECTION 9 (SPANNING PAGES 3 - 6)

Section 9 repeats content of the Final Office Action, mailed on November 14, 2008.

Appellant's Appeal Brief addresses that content.

In addition, Appellant makes the following replies.

ANSWER, SECTION 9, PAGE 3, LAST FULL PARAGRAPH

Point 1

The Answer asserts that Barcelou shows

> . . . an electronic payment mechanism for creating an electronic financial instrument for paying for an item purchased via the network, wherein the electronic financial instrument is independent of the payment from the user.
>
> (Answer, page 3, last full paragraph.)

This language, taken from the Answer, is a verbatim quote of original claim 1, as originally filed.

However, that language is not longer present in claim 1.

Therefore, the Answer's assertion is irrelevant.

Point 2

The Answer's assertion is factually incorrect. Stated in simple terms, the Answer's assertion is that Barcelou's machine makes a payment, which is "independent" of the payment by the user.

In response, Appellant points to the Appeal Brief, page 17, which states:

> However, Barcelou discusses no approach to making payment to the supposed third party, apart from the discussion at column 4, line 27 et seq.
>
> But that discussion merely refers to an ordinary credit card transaction, or similar, wherein the user of Barcelou's ATM provides a credit card number to the third-party seller.
>
> Therefore, under this interpretation, the third-party seller obtains a credit card

number, contrary to claim 1.

To repeat: Barcelou accepts the credit card number of a customer, and relays that number to a merchant.

That is not a payment which is "independent" of the payment of the customer.

It is **the same payment**.

Interim Conclusion

The Answer's paragraph is irrelevant to claim 1. It asserts that Barcelou shows some content of original claim 1. But original claim 1 is not in contention.

The Answer's paragraph is incorrect. The payment which Barcelou's machine makes is **NOT** "independent" of the customer's payment. It is **the same payment**. Thus, the claimed **two** payments are not present, as the Brief explains. (Eg, page 13, under heading "POINT 2.")

ANSWER, SECTION 10 (PAGES 6 AND 7)

Point 1 - Answer, Page 6, Section 10, First Two Paragraphs

The Answer, page 6, section 10, first two paragraphs, is self - contradictory.

The Answer first cites claim 1(b), which states, in part:

b) means for delivering a third party payment

> to a third party or merchant, who is different from the user and different from the operating party, which third party payment
>
> i) **is made using a credit card assigned to the terminal.**

The point here is that the payment is made using "a credit card assigned to the terminal."

The Answer then contradicts itself by stating:

> . . . the features upon which Appellant relies (ie, namely, that the ATM uses its own credit card to pay the seller) is/are not recited in the rejected claim(s).

Appellant repeats: The Answer first quotes claim 1(b), which recites "**a credit card assigned to the terminal.**" An ATM is a type of terminal.

Then the Answer asserts that this recitation, which the Answer found in claim 1(b), is not present in the claims.

The Answer is self - contradictory.

And the Answer's conclusion is impossible. The Answer cannot cite content of a claim, and then assert that the cited content is not present in the claims.

Further, claim 21(c) states:

> c) using a credit card account assigned to the ATM, transmitting payment to the selected merchant.

This claim recitation directly refutes the Answer's assertion.

Point 2 - Answer, Paragraph Bridging Pages 6 and 7, and First Full paragraph on Page 7

Comment 1

The Answer asserts that Barcelou does not **necessarily** identify the customer to the merchants.

Appellant points out that, even if this be true (which is not the case), that is insufficient. The claims state that **other information** is not given to the merchants.

Claim 1(c)(iii) states that the payment to the third party (eg, a merchant)

> iii) does not allow the third party to learn an account number of the user.

This recitation states that the third party does not learn "an account number of the user." It does not state that the **identity** of the user is not given to the third party. (Claim 1(c)(ii) states that.)

The passage cited by the Answer does not show that. The Answer asserts (incorrectly) that this passage states that the user's **identity** is not given to the third party. It does not mention the **account number** of claim 1(c)(iii).

Comment 2

The Answer, top of page 7, cites a passage from Barcelou. The Answer points out that Barcelou states that the customer is identified to "the system."

The Answer interprets this as meaning that the customer is identified to Barcelou's kiosk, and to nobody else.

Appellant points out that this restrictive interpretation is inconsistent with Barcelou's teachings.

In column 3, line 16 et seq., he states that his "system" is a combination of (1) an ATM plus (2) "at least two additional . . . retail services which are selected from" a "group" which Barcelou delineates. (Column 3, lines 29, 30.)

That "group" contains every retail merchant on the planet, most of which are located remotely from Barcelou's ATM.

Therefore, Barcelou's "system," upon which the Answer relies, cannot be interpreted as Barcelou's kiosk alone. His "system" includes an ATM plus at least two "retail services" which are remote from the ATM.

And the initial phrase of the passage of Barcelou cited by the Answer supports this conclusion. The initial phrase is "User access to systems provided according to the invention . . ." Those "systems" are identified in column 3, line 31 et seq.

Thus, in Barcelou, the user is identified to retail merchants which are remote from the ATM.

Point 3 - Answer, Page 7, Third Full Paragraph (Beginning with "Response to Points 6 and 7 . . .)

Summary

In re Keller and In re Merck & Co state that if a claim recites elements A and B, the fact that Reference 1 shows A but not B is not dispositive, when Reference 2 shows B.

One cannot attack Reference 1 "individually," and conclude that element B (not shown in that Reference 1) is not shown in the prior art. The reason is that Reference 2 shows element B.

Appellant is not doing that. Appellant is arguing that **none** of the references show certain claim elements.

Discussion

The Answer relies on In re Keller and In re Merck & Co for the proposition that "one cannot show non-obviousness by attacking references individually, where rejections are based on combinations of references."

The Answer mis-interprets the Keller and Merck cases. The relevant holding of those cases will be explained by way of example.

EXAMPLE

Assume that a **claim** recites elements A and B.

Assume that **reference 1** shows element A, **but not** B.

Assume, conversely, that **reference 2** shows element B, **but not** A.

These assumptions are repeated in tabular form:

ITEM IN QUESTION	CONTENT
Claim	Recites A and B
Reference 1	Shows A, not B
Reference 2	Shows B, not A

Keller and Merck state that the following argument is insufficient in this case.

INSUFFICIENT ARGUMENT

Reference 2 fails to show element A.

Reference 1 fails to show element B.

Therefore, the invention is not obvious.

The argument is insufficient because the two references are being **combined**. **When combined**, elements A and B are present in the combination.

Stated another way, the Argument given above, as a matter of logic, does not rebut a rejection. Even if Reference 2 fails to show element A, Reference 1 could show that element. A similar

comment applies to Reference 1, as to element B.

Therefore, Keller and Merck merely state what is now established law. The absence of a claim element from a first reference is not conclusive. A second reference can show that claim element. One cannot successfully attack the first reference "individually," on the ground that the claim element is missing from that reference.

APPELLANT'S ARGUMENT IS DIFFERENT FROM THE EXAMPLE

However, Appellant is not making this type of argument.

Instead, Appellant points out that **even after combination,** elements of the claims are **still missing**. The Applicants in Keller and Merck did not make such an argument.

Point 4 - Answer, Page 7, Fourth Full Paragraph (Beginning with "In This Regard . . .)

This paragraph asserts that an "internet browser" is an "alternative" to Barcelou's "touch screen."

Appellant points out that an "internet browser" is a piece of software. A "touch screen" is a TV screen.

MPEP § 2144.06 states:

> In order to rely on equivalence as a rationale supporting an obviousness rejection, **the equivalency must be recognized in the prior art**, and cannot be based on . . . the mere fact that the components at issue are

functional or mechanical equivalents.

No such showing has been made.

The Brief, page 18, beginning with the heading "POINT 7," rebuts this assertion of the Answer.

CONCLUSION

Appellant requests that the Board reverse all rejections, and pass all claims to issue.

Respectfully submitted,

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